



Docket No. FJ-2001-041-US  
(MAS.012)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Application of

Hisayoshi Tsubaki

Serial No.: 10/058,924

Group Art Unit: 2625

Filed: January 30, 2002

Examiner: Perungavoor, Sathyanaraya V.

For: IMAGE RECORDING METHOD AND SYSTEM, IMAGE TRANSMITTING  
METHOD, AND IMAGE RECORDING APPARATUS

Honorable Commissioner of Patents  
Alexandria, VA 22313-1450

**APPELLANT'S REPLY BRIEF UNDER 37 C.F.R. § 41.41**

Sir:

Appellant respectfully replies to the Examiner's Answer of September 20, 2006, and requests reconsideration of the appeal of the final rejection of claims 1-41 in the Office Action dated November 29, 2005.

**I. REAL PARTY IN INTEREST**

The real party in interest is FUJI PHOTO FILM CO., LTD., assignee of 100% interest of the above-referenced patent application.

**II. RELATED APPEALS AND INTERFERENCES**

There are no other appeals or interferences known to Appellants, Appellants' legal representative or Assignee which would directly affect or be directly affected by or have a bearing on the Board's decision in this appeal.

### III. STATUS OF CLAIMS

Claims 1-41, all the claims presently pending in the application, stand rejected on prior art grounds.

Claims 1-3, 12, 37, 38, and 40 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over McDonald (U.S. Patent No. 5,920,317) in view of Wang (U.S. Patent No. 6,038,333).

Claims 4, 11, and 13 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over McDonald in view of Wang, and in further view of "Core Bibliographic Information in the TIFF Header", [http://gdz.sub.uni-goettingen.de/en-old/tech\\_notes/tiffheader.html](http://gdz.sub.uni-goettingen.de/en-old/tech_notes/tiffheader.html), updated February 14, 1999) (hereinafter "TIFF").

Claims 5-7, 9, 10, 15-17, 19-21, and 39 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over McDonald in view of Wang, and further in view of Kuperstein (U.S. Patent No. 6,128,398).

Claims 8, 18, and 22 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over McDonald in view of Wang, and further in view of Kuperstein, and further in view of TIFF.

Claims 14 and 23-36 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Allen et al. (U.S. Patent No. 5,737,491).

Claim 41 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over McDonald in view of Wang, and further in view of Allen.

Appellants respectfully appeal the rejections of Claims 1-3, 12, 37, 38, and 40 under 35 U.S.C. § 103(a), Claims 4, 11, and 13 under 35 U.S.C. § 103(a), Claims 5-7, 9, 10, 15-17, 19-21, and 39 under 35 U.S.C. § 103(a), Claims 8, 18, and 22 under 35 U.S.C. § 103(a), Claims 14 and 23-36 under 35 U.S.C. § 103(a), and Claim 41 under 35 U.S.C. § 103(a), which are the sole issues in this Appeal.

#### **IV. STATUS OF AMENDMENTS**

An Amendment under 37 C.F.R. § 1.116 was filed on February 16, 2006. No claims were amended. Also, a Corrected Amendment under 37 C.F.R. § 1.116 was filed on May 1, 2006, merely to properly list the pending claims. No claims were amended.

An Advisory Action mailed March 13, 2006, stated that the Request for Reconsideration had been considered but did not place the application in condition for allowance, and thus, held Claims 1-41 unpatentable.

A Notice of Appeal was filed timely on May 1, 2006.

Therefore, the claims are pending as set forth in the Appendix.

#### **V. SUMMARY OF THE CLAIMED SUBJECT MATTER**

Appellants' invention, as disclosed and claimed (e.g., as exemplarily defined in claims 1-41) is directed to an image recording method, an image transmitting method, and an image recording apparatus, and in particular, to an image recording method, an image transmitting method, and an image recording apparatus wherein identification information identifying a subject is recorded in connection with the subject, as well as an image recording

method and apparatus which records added-to-image information in connection with an image of a subject (e.g., see specification at page 1, lines 5-10).

Conventional medical systems introduced into hospitals have identification information on patients (patient IDs) and the patients' diagnosis images or case records relatedly recorded in a database so that the diagnosis images can be read out from the database for use as required. On the other hand, an image photographed using a digital camera is associated with a patient ID. For example, first, the patient ID (number) and the diagnosis image are photographed in connection with each other. Then, the photographed image is associated with the patient ID. Alternatively, the patient ID is input from a keyboard connected to the digital camera, and a folder identical to that for the patient ID is created so that a photographed image is recorded in this folder (e.g., see specification at page 1, lines 12-22).

The first method is cumbersome because it requires extra operations of photographing the patient ID and associating the photographed image with the patient ID. On the other hand, in the method 2), an operator manually inputs the patient ID, so that an input error is likely to occur, causing the patient to be mistaken for another patient. Further, if an input error occurs, it cannot be easily detected. Furthermore, since the keyboard is connected to the digital camera, it may obstruct the movement of the camera or a change in camera angle during photographing (e.g., see specification at page 1, lines 23-29).

Moreover, with the conventional medical systems, even if a patient ID is displayed on the display of the camera as additional information, it cannot be checked on the basis of the contents of the display whether or not this patient ID matches the patient ID imparted to the patient to be photographed. This results in the need for an extra operation of simultaneously

photographing the patient and the patient ID (number) or the like and associating the photographed image with the patient ID, which is cumbersome (e.g., see specification at page 2, line 32, and page 3, lines 1-5).

Further, with a large amount of additional information, the restricted display of the camera (for example, a character liquid crystal) does not allow the entire information to be displayed, thereby also preventing the photographer from checking what additional information is added to the image (e.g., see specification at page 3, lines 6-9).

On the other hand, the claimed invention (e.g., see independent claims 1 and 15) provides an image recording method and apparatus which can simplify the input of identification information on a subject, which enables an easy check on the correspondence between the subject identification information input before photographing and the subject to be photographed, and which can automatically record information in a format suitable for a database (e.g., see specification at page 3, lines 11-16).

The claimed invention (e.g., see independent claim 14) also provides an image transmitting method which can simplify the input of information on the destination of an image and which can automatically transmit a photographed image to a destination corresponding to the destination information (e.g., see specification at page 3, lines 17-20).

The claimed invention (e.g., see independent claims 23 and 36) also provides an image recording method and system wherein if additional information input from an external device is recorded in connection with an image of the subject, a camera can be used to easily check what added-to-image information is added, whether or not the added-

to-image information is correct as information added to the image of the subject, and the like (e.g., see specification at page 3, lines 21-25).

Each of the claims is described in more detail below.

For example, as exemplarily defined by independent claim 1, an image recording method, includes an information loading step (e.g., see Figure 7, S16) of loading identification information on a subject and subject information used by a photographer to confirm an identity of the subject, in a digital camera (e.g., 30) before photographing the subject (e.g., see specification at page 12, lines 22-29), a display step (e.g., see Figure 7, S20) of displaying, on the basis of the subject information, subject information used by the photographer to confirm the identity of the subject on a display device of the digital camera (e.g., 30) before photographing the subject (e.g., see specification at page 12, lines 30-32, and page 13, lines 1-2), a photographing step (e.g., Figure 7, S22) of photographing the subject using the digital camera (e.g., 30) after confirming the identity of the subject on the basis of the subject information displayed on the display device (e.g., see specification at page 13, lines 3-4), and a recording step (e.g., Figure 7, S24) of recording the photographed image of the subject in connection with the identification information loaded in the information loading step (e.g., see Figure 7, S16)(e.g., see specification at page 13, lines 7-11).

As exemplarily defined by claim 2, the image recorded in connection with the identification information is saved to a database (e.g., 20) (e.g., see specification at page 13, lines 12-15).

As exemplarily defined by claim 3, the subject information includes at least one of the subject's photograph and name (e.g., see specification at page 13, lines 27-29).

As exemplarily defined by claim 4, the recording step (e.g., Figure 7, S24) records the identification information loaded in the information loading step (e.g., see Figure 7, S16), in a header part of an image file in which the photographed subject image is recorded (e.g., see specification at page 13, lines 7-11).

As exemplarily defined by claim 5, the information loading step (e.g., see Figure 7, S16) includes a step of reading the subject identification information (e.g., see figure 7, S10) from a recording medium having the identification information recorded thereon (e.g., see specification at page 12, lines 24-26), a step of reading the subject information (e.g., see Figure 7, S14) corresponding to the read identification information, from a database (e.g., 20) having the subject information already stored in connection with the subject identification information (e.g., see specification at page 12, lines 27-28), and a transmitting step (e.g., see Figure 7, S26) of transmitting the subject information read from the database (e.g., 20), to the digital camera (e.g., 30) together with the identification information read from the recording medium (e.g., see specification at page 12, lines 28-29).

As exemplarily defined by claim 6, while the subject identification information and the subject information are being transmitted to the digital camera (e.g., 30), the digital camera (e.g., 30) is inhibited from being used for photographing (e.g., see specification at page 13, lines 4-6).

As exemplarily defined by claim 7, the subject information includes at least one of the subject's photograph and name (e.g., see specification at page 13, lines 27-29).

As exemplarily defined by claim 8, the recording step (e.g., Figure 7, S24) records the identification information loaded in the information loading step (e.g., see Figure 7, S16), in a header part of an image file in which the photographed subject image is recorded (e.g., see specification at page 13, lines 7-11).

As exemplarily defined by claim 9, the step of reading (e.g., Figure 7, S14) the identification information reads plural pieces of identification information so that these pieces can be accumulated (e.g., see specification at page 13, lines 18-22), and the transmitting step (e.g., see Figure 7, S26) transmits the identification information and the subject information in response to an information obtainment request from the digital camera (e.g., 30) (e.g., see specification at page 13, lines 19-22).

As exemplarily defined by claim 10, while the subject identification information and the subject information are being transmitted to the digital camera (e.g., 30), the digital camera (e.g., 30) is inhibited from being used for photographing (e.g., see specification at page 13, lines 4-6).

As exemplarily defined by claim 11, the information loading step (e.g., see Figure 7, S16) loads recorded image information containing at least one of image format, the number of pixels, compression rate, file size, and image aspect ratio (e.g., see specification at page 10, lines 12-18, and page 12, lines 30-32), and the digital camera (e.g., 30) records the photographed image on the basis of the loaded recorded image information (e.g., see specification at page 12, lines 12-16, and 30-32).



As exemplarily defined by claim 12, the subject information includes at least one of the subject's photograph and name (e.g., see specification at page 13, lines 27-29).

As exemplarily defined by claim 13, the recording step (e.g., Figure 7, S24) records the identification information loaded in the information loading step (e.g., see Figure 7, S16), in a header part of an image file in which the photographed subject image is recorded (e.g., see specification at page 12, lines 4-7 and 9-10).

As exemplarily defined by independent claim 14, an image transmitting method, includes an input step (e.g., see Figure 10, S50) of inputting destination information from an external device (e.g., PDA 50) to a digital camera (e.g., 30)(e.g., see specification at page 14, lines 20-24, page 15, lines 3-6; see also Figures 8 and 9), the information being indicative of a destination of an image (e.g., see specification at page 14, lines 5-9; Figures 8 and 9), wherein the input step inputs destination information to the digital camera (e.g., 30) using radio communication before photographing a subject to be photographed (e.g., see specification at page 15, line 12), a photographing step (e.g., Figure 10, S52) of photographing the subject using the digital camera (e.g., 30)(e.g., see specification at page 15, lines 12-14), a recording step (e.g., Figure 10, S54) of recording the photographed image of the subject in connection with the destination information input in the input step (e.g., see Figure 10, S50), and a transmitting step (e.g., see Figure 10, S66, S72) of transmitting the photographed subject image to the destination corresponding to the destination information (e.g., see specification at page 15, lines 17-32, page 16, lines 1-15 and 19-23), on the basis of the destination information recorded in connection with the image (e.g., see specification at page 15, lines 17-20).

As exemplarily defined by independent claim 15, an image recording apparatus (e.g., see Figure 1) includes an input device (e.g., see Figure 1, input apparatus 10) which reads identification information on a subject from a recording medium (e.g., see Figure 1, ID card 11) having the information recorded thereon (e.g., see specification at page 9, lines 20-23), an information transmitting device (e.g., see Figure 1, computer 12) which reads subject information corresponding to the read identification information, from a database (e.g., 20) having the subject information already stored in connection with the subject identification information (e.g., see specification at page 9, lines 20-28) and transmits the subject information read from the database (e.g., 20), together with the identification information read from the recording medium (e.g., 11)(e.g., see Figures 1 and 3; see also specification at page 9, lines 29-31, and page 10, lines 1-23), wherein the subject information includes information that can be used to confirm an identity of the subject to be photographed (e.g., see specification at page 12, lines 2-4), a receiving device (e.g., Figure 4, 360, 362) which receives the identification information and the subject information (e.g., see specification at page 11, lines 19-24), a display device (e.g., see Figure 4, 372) which displays the subject information on the basis of the received subject information before photographing the subject (e.g., see specification at page 11, lines 25-29), a photographing device (e.g., see Figure 4, 302) which photographs the subject (e.g., see specification at page 10, lines 24-32), and a recording device (e.g., see Figure 4, 330, 332) which records the photographed subject image in connection with the received identification information (e.g., see specification at page 11, lines 10-18).

As exemplarily defined by claim 16, the recording medium (e.g., 11)(e.g., see Figures 1 and 3; see also specification at page 9, lines 29-31, and page 10, lines 1-23) includes one of a card, a magnetic card, and an IC card including a bar code recorded thereon (e.g., see specification at page 9, lines 20-23), and the input device includes a card reader (e.g., see Figure 1, 10).

As exemplarily defined by claim 17, the image recording apparatus further includes a communication device (e.g., see Figure 4, 360, 362) which transmits the image recorded in connection with the identification information, to the database (e.g., 20)(e.g., see specification at page 11, lines 19-24, and page 12, lines 9-11).

As exemplarily defined by claim 18, the recording device (e.g., see Figure 4, 330, 332) records the identification information in a header part of an image file in which the photographed subject image is recorded (e.g., see specification at page 12, lines 4-8).

As exemplarily defined by independent claim 19, an image recording apparatus, includes an input device (e.g., see Figure 1, input apparatus 10) which reads subject identification information and subject information from a recording medium (e.g., see Figure 1, ID card 11) having the identification information and the subject information recorded thereon (e.g., see specification at page 9, lines 20-23), wherein the subject information includes information that can be used to confirm an identity of the subject to be photographed (e.g., see specification at page 12, lines 2-4), a display device (e.g., see Figure 4, 372) which displays the subject information on the basis of the read subject information before photographing the subject (e.g., see specification at page 11, lines 25-29), a photographing device (e.g., see Figure 4, 302) which photographs the subject (e.g.,

see specification at page 10, lines 24-32), and a recording device (e.g., see Figure 4, 330, 332) which records the photographed image of the subject in connection with the read identification information (e.g., see specification at page 11, lines 10-18).

As exemplarily defined by claim 20, the recording medium (e.g., 11)(e.g., see Figures 1 and 3; see also specification at page 9, lines 29-31, and page 10, lines 1-23) includes one of a card, a magnetic card, and an IC card including a bar code recorded thereon (e.g., see specification at page 9, lines 20-23), and the input device includes a card reader (e.g., see Figure 1, 10).

As exemplarily defined by claim 21, the image recording apparatus further includes a communication device (e.g., see Figure 4, 360, 362) which transmits the image recorded in connection with the identification information, to the database (e.g., 20)(e.g., see specification at page 11, lines 19-24, and page 12, lines 9-11).

As exemplarily defined by claim 22, the recording device (e.g., see Figure 4, 330, 332) records the identification information in a header part of an image file in which the photographed subject image is recorded (e.g., see specification at page 12, lines 4-8).

As exemplarily defined by independent claim 23, an image recording method, includes inputting (e.g., see specification at page 12, lines 24-29) added-to-image information (e.g., see Figures 3, 5, 16, and 21-23) added to an image of a subject to be photographed and display information (e.g., see Figures 3, 5, 16, and 21-23) associated with the added-to-image information to a digital camera (e.g., 30) from an external device (e.g., see Figure 1; 10, 11, 12, 20, etc.) using radio communication before photographing the subject to be photographed, displaying (e.g., see Figure 7, S20) the display

information on a display device (e.g., see Figure 4, 372) of the digital camera (e.g., 30) on the basis of the display information input from the external device (e.g., see specification at page 12, lines 24-29) before photographing the subject to be photographed (e.g., see specification at page 11, lines 25-29), and after photographing the subject, recording an image of the subject and the added-to-image information input from the external device (e.g., see Figure 1; 10, 11, 12, 20, etc.) in connection with the image (e.g., see specification at page 13, lines 3-11).

As exemplarily defined by claim 24, the display information is used by a photographer to check at least one of contents and correctness of the added-to-image information added to the subject image (e.g., see specification at page 12, lines 2-4 and 32, page 13, lines 1-2).

As exemplarily defined by claim 25, the display information includes one of test information and image information which can be displayed on the display device (e.g., see specification at page 11, lines 30-32; see also Figures 3, 5, 16, and 21-23, etc.).

As exemplarily defined by claim 26, the added-to-image information includes binary information, and the display information includes text information corresponding to the binary information (e.g., see specification at page 1321, lines 23-30, page 24, lines 30-32, page 25, lines 1-3, page 25, line 32, and page 26, lines 1-4).

As exemplarily defined by claim 27, the added-to-image information is recorded in a header part of an image file in which an image of the subject is recorded (e.g., see specification at page 13, lines 7-11, page 19, lines 15-17).

As exemplarily defined by claim 28, the display information includes at least one of test information and image information which can be displayed on the display device (e.g., see specification at page 13, lines 3-11).

As exemplarily defined by claim 29, the added-to-image information includes binary information, and the display information includes text information corresponding to the binary information (e.g., see specification at page 11, lines 30-32; see also Figures 3, 5, 16, and 21-23, etc.).

As exemplarily defined by claim 30, the added-to-image information is recorded in a header part of an image file in which an image of the subject is recorded (e.g., see specification at page 13, lines 7-11, page 19, lines 15-17).

As exemplarily defined by claim 31, the added-to-image information includes at least one of numerical locational information on the subject and identification information already imparted to the subject (e.g., see specification at page 21, lines 28-32, page 22, lines 1 and 16-26, page 23, lines 15-27; see also Figures 11, 15, and 16).

As exemplarily defined by claim 32, the display information is used by a photographer to check at least one of contents and correctness of the added-to-image information added to the subject image (e.g., see specification at page 12, lines 2-4 and 32, and page 13, lines 1-2).

As exemplarily defined by claim 33, the display information includes one of test information and image information which can be displayed on the display device (e.g., see specification at page 11, lines 30-32; see also Figures 3, 5, 16, and 21-23).

As exemplarily defined by claim 34, the added-to-image information includes binary information, and the display information includes text information corresponding to the binary information (e.g., see specification at page 21, lines 23-30, page 24, lines 30-32, page 25, lines 1-3 and 32, and page 26, lines 1-4).

As exemplarily defined by claim 35, the added-to-image information is recorded in a header part of an image file in which an image of the subject is recorded (e.g., see specification at page 13, lines 7-11, page 19, lines 15-17).

As exemplarily defined by independent claim 36, an image recording system includes an external device (e.g., see Figure 1; 10, 11, 12, 20, etc.) which outputs, using radio communication, added-to-image information added to an image of a subject to be photographed and display information associated with the added-to-image information (e.g., see specification at page 12, lines 24-29), and a digital camera (e.g., 30), which includes a display device (e.g., see Figure 4, 372) which displays the display information on the basis of the display information input from the external device using radio communication before photographing the subject to be photographed (e.g., see specification at page 11, lines 25-29), and a recording device (e.g., see Figure 4, 330, 332) which records an image of the subject after the subject has been photographed and records the added-to-image information input from the external device, in connection with the image (e.g., see specification at page 11, lines 10-18, and page 13, lines 3-11).

As exemplarily defined by claim 37, the identification information includes information that can be used to confirm an identity of the subject to be photographed (e.g., see specification at page 12, lines 2-4).

As exemplarily defined by claim 38, the image recording method further includes confirming an identity of the subject to be photographed using the subject information (e.g., see specification at page 12, lines 2-4, and page 25, lines 18-22).

As exemplarily defined by claim 39, the information loading step (e.g., see Figure 7, S16) includes at least one of loading the identification information in the digital camera (e.g., 30) using radio communication (e.g., see specification at page 9, lines 26-28, page 14, lines 20-24, and page 18, lines 24-27) and loading the identification information from a recording medium (e.g., see specification at page 13, lines 23-26, and page 17, lines 18-19).

As exemplarily defined by claim 40, the information loading step (e.g., see Figure 7, S16) automatically loads the identification information on the subject and the subject information used by the photographer to confirm the subject, in the digital camera (e.g., 30) before photographing the subject (e.g., see specification at page 12, lines 12-16).

As exemplarily defined by independent claim 41, an image transmitting method, includes inputting identification information on a subject and subject information (e.g., see Figure 7, S16; see also specification at page 12, lines 22-29), and destination information (e.g., see Figure 10, S50; see also specification at page 14, lines 5-9, and page 15, line 12) from an external device (e.g., PDA 50) to a digital camera (e.g., 30), before photographing the subject, wherein the subject information includes information used by a photographer to confirm the identity of the subject, before photographing the subject (e.g., see specification at page 12, lines 30-32, and page 13, lines 1-2), and wherein the destination information includes information indicative of a destination of an



image (e.g., see specification at page 14, lines 5-9), displaying (e.g., see Figure 7, S20), on the basis of the subject information, subject information for confirming the identity of the subject on a display device of the digital camera (e.g., 30), before photographing the subject (e.g., see specification at page 12, lines 30-32, and page 13, lines 1-2), photographing (e.g., see Figure 7, S22) the subject using the digital camera (e.g., 30) after confirming the identity of the subject on the basis of the subject information displayed on the display device (e.g., see specification at page 13, lines 3-4), recording (e.g., see Figure 7, S24; Figure 10, S54) the photographed image of the subject in connection with the identification information (e.g., see Figure 7, S16) and the destination information (e.g., see Figure 10, S50) input, and transmitting (e.g., see Figure 10, S66, S72) the photographed subject image to the destination corresponding to the destination information (e.g., see specification at page 15, lines 17-32, page 16, lines 1-15, and page 16, lines 19-23), on the basis of the destination information recorded in connection with the image (e.g., see specification at page 15, lines 17-20; see also Figure 10, S54).

## **VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL**

The issues presented for review by the Board of Patent Appeals and Interferences are whether:

- Claims 1-3, 12, 37, 38, and 40 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over McDonald in view of Wang;

- Claims 4, 11, and 13 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over McDonald in view of Wang, and in further view of TIFF;
- Claims 5-7, 9, 10, 15-17, 19-21, and 39 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over McDonald in view of Wang, and further in view of Kuperstein;
- Claims 8, 18, and 22 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over McDonald in view of Wang, and further in view of Kuperstein, and further in view of TIFF;
- Claims 14 and 23-36 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Allen; and
- Claim 41 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over McDonald in view of Wang, and further in view of Allen.

## **VII. ARGUMENT**

### **A. EXAMINER'S ANSWER AND APPELLANTS' RESPONSE THERE TO**

#### **Claims 1-3, 12, 37, 38, and 40**

With respect to independent claims 1-3, 12, 37, 38, and 40, in the Examiner's Answer dated September 20, 2006, the Examiner argues that whether the method/system requires a centralized or decentralized database is not required in the claims, and also allegedly is not relevant to the claims or rejections as a whole.

However, whether the applied references relate to a centralized or decentralized database clearly is relevant to the obviousness of combining the applied references, irrespective of whether the claim specifically recites such a feature.

As the Examiner points out, the test for obviousness is what the combined teachings of the references would have suggested to those of ordinary skill in the art.

Thus, as discussed in more detail below, Appellants respectfully disagree with the Examiner's Answer, and therefore, traverse this rejection for similar reasons as those set forth in the Appeal Brief, which are reiterated below for the Examiner's convenience.

Appellants note that merely identifying the individual elements of the claims in separate references is not sufficient to establish the obviousness of the claims. Moreover, the mere fact that references can be combined or modified is not sufficient to establish *prima facie* obviousness. The Office Action must establish a reasonable motivation or suggestion for combining the references to arrive at the claimed invention. Moreover, the references cannot be combined where the references teach away from their combination.

The references as a whole must be considered for what they fairly teach or suggest to the ordinarily skilled artisan.

Contrary to the Examiner's position, Appellants respectfully reiterate that it would not have been obvious to combine the teachings of McDonald and Wang to arrive at the claimed invention. That is, one of ordinary skill in the art would not have been motivated to combine a system and method which imperatively uses a centralized database (i.e., a centralized system and method), as disclosed by McDonald, with the decentralized system and method which is disclosed by Wang.

In other words, Appellants submit that the ordinarily skilled artisan would not have been motivated by the teachings of McDonald, which are directed to a centralized database, and the teachings of Wang, which are directed to a decentralized system and method, to arrive at the claimed invention.

It would not have been obvious to modify the system and method of McDonald, which states that it is “*imperative that ultrasound scan facilities such as hospitals maintain impeccable records for identifying and tracking ultrasound scans to ensure that each scan is accurately and permanently associated with a specific patient and a specific date*” (see McDonald at column 5, lines 1-5; emphasis added) and which performs a search of a central database, in view of Wang, which discloses a personal identifier and management system that is a single stand-alone portable hand held device that fits into a user's single hand, wherein the image database, the image capturing system, the display system, and the face analysis system all physically reside in the single stand-alone portable hand held device (see Wang at column 8, lines 59-61).

Appellants submit that it is not enough to merely “pick-and-choose” the elements of the claimed invention from the references and combine them to arrive at the invention.

Instead, the references must provide some motivation for doing that which the inventors have done. That is, there must be some motivation or suggestion for combining the references to arrive at the claimed invention.

#### **Claims 14 and 23-26**

With respect to independent claims 14 and 23, and dependent claims 24-26, in the Examiner's Answer dated September 20, 2006, the Examiner argues that the portions of

the disclosure, which are cited by appellants (e.g., specification at page 1, lines 12; page 3, line 3; page 4, lines 22-23; page 14, line 3 to page 18, line 2), allegedly do not show the criticality of inputting before as opposed to after, and therefore, the Examiner deems the design choice rejection to be valid (see Examiner's Answer at page 22, lines 14-19).

Appellants respectfully disagree.

First, Appellants submit that the specification of the present application clearly shows the criticality of inputting the information before photographing the subject, as opposed to after photographing the subject (e.g., see specification at page 4, lines 22-23; see also page 14, line 3, to page 18, line 2). (see also page 4, lines 4-10)

That is, the specification clearly explains an important advantage of the claimed method recited in independent claim 14, in that the display device of the digital camera first displays the subject information on the subject to be photographed before photographing the subject, in order to enable the subject to be confirmed on the basis of the displayed subject information (see specification at page 4, lines 4-10).

The ordinarily skilled artisan clearly would recognize that the input step of inputting the information before the photographing step clearly is critical to being able to perform a step of confirming the subject based on such information before photographing the subject. If such information were not available before the photographing step was performed, then the user clearly could not perform the confirming prior to performing the photographing step.

Appellants respectfully submit that the disclosure identifies numerous problems associated with inputting the information after photographing the subject, as well as

specific advantages obtained by inputting the information before photographing the subject. Moreover, the present application clearly discloses and claims a device that requires that the information be input before photographing the subject.

Second, it is noted that the Examiner relies on In re Woodruff, 919 F.2d 1575, 16 USPQ2d 1934 (Fed. Cir. 1990), to support the position that appellants must show that a particular range is critical, generally by showing that the claimed range achieves unexpected results relative to the prior art range. However, Appellants respectfully submit that the claims at issue are not directed to a claimed range, and therefore, the Examiner's reliance on In re Woodruff is misplaced.

On the contrary, independent claim 14 clearly recites the steps of an image transmitting method, and more particularly, a particular order of method steps for achieving important advantages, and avoiding the problems with the conventional methods, which Appellants have recognized and identified in the present application.

Specifically, claim 14 recites:

14. *An image transmitting method, comprising:  
an input step of inputting destination information from  
an external device to a digital camera, the information being  
indicative of a destination of an image, wherein said input step  
inputs destination information to the digital camera using radio  
communication before photographing a subject to be  
photographed;  
a photographing step of photographing the subject using  
the digital camera;*

*a recording step of recording the photographed image of  
the subject in connection with the destination information input  
in the input step; and*

*a transmitting step of transmitting the photographed  
subject image to the destination corresponding to the  
destination information, on the basis of the destination  
information recorded in connection with the image (emphasis  
added).*

Clearly, the order in which steps of a method are performed is not the same as, or comparable to, a particular range. Thus, the facts of In re Woodruff are not relevant to the facts of the present application. Hence, the Examiner's reliance on In re Woodruff is believed to be misplaced.

Third, the Examiner cites In re Japikse, 181 F.2d 1019, 86 USPQ 70 (CCPA 1950), in support of this position. However, In re Japikse relates to the position of a starter switch in a hydraulic power press, not to an order of performing method steps, as in the claimed invention. Hence, the Examiner's reliance on In re Japikse also is believed to be misplaced.

Fourth, the Examiner specifically agreed that the cited portions of the specification disclose the advantages of automatic entry as opposed to manual entry (see Examiner's Answer at page 23, lines 3-4). However, the Examiner stated that such is not the basis for the design choice rejection.

Instead, the Examiner specifically states that the design choice rejection is based on the inputting of information after photographing the subject as being equivalent to inputting information before photographing the subject.

Appellants respectfully disagree.

Contrary to the Examiner's position, inputting of information after photographing clearly is not equivalent to inputting information before photographing, when considered in view of the claimed method as a whole.

The present invention clearly describes important advantages that can be obtained by providing an input step of inputting the information before performing the photographing step of photographing the subject.

Specifically, the specification clearly explains an important advantage of the claimed method recited in independent claim 14, in that the display device of the digital camera first displays the subject information on the subject to be photographed before photographing the subject, in order to enable the subject to be confirmed on the basis of the displayed subject information (see specification at page 4, lines 4-10).

Particularly, independent claim 14 clearly recites a method including an input step of inputting destination information from an external device to a digital camera, the information being indicative of a destination of an image. Claim 14 specifically recites that the "*input step inputs destination information to the digital camera using radio communication before photographing a subject to be photographed*" (emphasis added).

Next, in the photographing step, the subject is photographed using the digital camera.



After the subject is photographed, claimed 14 recites a recording step of recording the photographed image of the subject in connection with the destination information input in the input step" (emphasis added). In other words, claim 14 specifically requires that the input step be performed before the photographing step. On the other hand, the photographing step clearly must be performed before the photographed image can be recorded. Thus, the input step must be performed before the recording step.

Indeed, one of ordinary skill in the art would recognize that the input step also must be performed before the photographing step of photographing the subject if the photograph of the subject is to be recorded in connection with the information that is input in the input step.

In this regard, the present application explains that the photographed image of the subject would have his or her identification information recorded thereon in connection with the subject information on a one-to-one correspondence, so that the subject image confirmed on the basis of the subject information is associated with the subject identification information (see specification at page 4, lines 4-10).

Somewhat similarly, independent claim 23 recites:

23. *An image recording method, comprising:*  
*inputting added-to-image information added to an image*  
*of a subject to be photographed and display information*  
*associated with the added-to-image information to a digital*  
*camera from an external device using radio communication*  
*before photographing the subject to be photographed;*  
*displaying the display information on a display device of*  
*the digital camera on the basis of the display information input*

*from the external device before photographing the subject to be photographed; and  
after photographing the subject, recording an image of the subject and the added-to-image information input from the external device in connection with the image (emphasis added).*

Independent claim 23 specifically recites “*after photographing the subject, recording*” an image and the information in connection with the image.

Thus, for at least the reasons set forth above, when considered in the context of the claimed invention as a whole, a step of inputting the information after photographing the subject clearly is not equivalent to a step of inputting the information before photographing the subject.

Indeed, Appellants respectfully submit that inputting the information after performing the photographing step of photographing the subject ignores the specific advantages of the claimed invention described in the specification, as well as the specific disadvantages of the conventional methods which input information after performing the photographing step.

In view of the above, the specific features of independent claims 14 and 23 could not be performed if the allegedly equivalent step of inputting the information after the photographing step were performed, since the claim itself requires the inputting step to be performed before certain additional steps can be performed (e.g., recording step, etc.).

Thus, for at least the foregoing reasons, Appellants respectfully disagree with the Examiner's positions in the Examiner's Answer, and therefore, request that the Examiner reconsider and withdraw this rejection.

**B. EXAMINER'S POSITION**

**Advisory Action**

Turning to Advisory Action, Appellants respectfully reiterate the traversal position set forth in the Appeal Brief.

In the Advisory Action, the Examiner indicated that the request for reconsideration had been considered but did not place the application in condition for allowance because:

“Regarding claim 1-3, 12, 37, 38, and 40, Applicant argue that McDonald and Wang are not combinable because one discloses a centralized database and the other discloses a decentralized one. Examiner respectfully disagrees. The main reason Wang is used to show that subject information (i.e., name) can be displayed on a display device. Displaying information on display devices, which notoriously well known, is not dependent whether the database is decentralized nor does this teach away from displaying. So, the Examiner fails to see and the Applicants failed to provide sufficient evidence to suggest why someone would not display subject information with a display device. Regarding claims 14 and 23-26, Applicants argue that sufficient evidence is provided to support the advantages of “inputting the destination information before photographing”. Applicants cite page 4, lines 22-23 as providing that support. Applicant further argue that Allen does not disclose the “inputting the destination information of the image before taking the photograph of the subject”. Examiner respectfully disagrees. Examiner does not see anywhere the citation to provide the advantages; it only recites the disadvantages of manual entry. However, the evidence needed is the advantages

of, inputting the destination information BEFORE photographing, as opposed to inputting destination information AFTER photographing. Examiner maintains that Allen does disclose inputting of the destination information, see column 3, lines 1-3 and 58-62.”

(see Advisory Action mailed March 13, 2006, at page 2).

Therefore, the Examiner maintained the final rejections of claims 1-41, as set forth in the final Office Action mailed on November 29, 2005.

### **C. APPELLANTS' POSITION**

For at least the foregoing reasons, Appellants respectfully disagree with the Examiner's positions, and therefore, Appellants traverse each of the Examiner's rejections.

i) Claims 1-3, 12, 37, 38, and 40 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over McDonald in view of Wang.

#### **Final Office Action**

The Examiner alleges that McDonald discloses all of the features of the claimed invention, except that McDonald does not explicitly disclose displaying the subject information on a display device of a digital camera (see Office Action at page 3, last paragraph).

However, the Examiner alleges that it would have been obvious to combine McDonald with Wang to arrive at the claimed invention because they are in the same

field of subject verification and imaging. The Examiner alleges that it would have been obvious to modify the teachings of McDonald with Wang to display the "subject information" on the display device of the digital camera, the motivation being to create a portable handheld device (citing Wang at column 8, lines 60-61).

#### **Advisory Action**

With respect to the Examiner's position in the Advisory Action mailed March 13, 2006, Appellants respectfully disagree with the Examiner's position, and therefore, traverse this rejection for at least the following reasons.

In the Advisory Action, the Examiner states that the main reason Wang is used is to show that subject information (i.e., name) can be displayed on a display device. The Examiner asserts that displaying information on display devices is notoriously well known, and is not dependent whether the database is decentralized nor does this teach away from displaying. The Examiner asserts that the Examiner fails to see and the Applicants allegedly failed to provide sufficient evidence to suggest why someone would not display subject information with a display device.

Appellants note, however, that the Examiner relies on Wang for more than simply displaying on a display device. Instead, the Examiner relies on Wang for the teaching and suggestion of displaying on a portable handheld device, such as a digital camera.

That is, in the final Office Action mailed November 29, 2005, the Examiner acknowledges that McDonald does not explicitly disclose displaying the subject information on a display device of a digital camera (see Office Action at page 3, last paragraph). The Examiner alleges that it would have been obvious to combine McDonald

with Wang to arrive at the claimed invention because they are in the same field of subject verification and imaging. The Examiner alleges that it would have been obvious to modify the teachings of McDonald with Wang to display the "subject information" on the display device of the digital camera, the motivation being to create a portable handheld device (citing Wang at column 8, lines 60-61).

Appellants submit that the references as a whole must be considered in determining the obviousness of the claimed invention, and whether the claimed invention would have been obvious in view of the cited references.

First, it is also noted that, merely identifying the individual elements of the claims in separate references is not sufficient to establish the obviousness of the claims. Moreover, the mere fact that references can be combined or modified is not sufficient to establish *prima facie* obviousness. The Office Action must establish a reasonable motivation or suggestion for combining the references to arrive at the claimed invention. Moreover, the references cannot be combined where the references teach away from their combination.

Again, the references as a whole must be considered for what they fairly teach or suggest to the ordinarily skilled artisan.

Contrary to the Examiner's position, Appellants respectfully submit that it would not have been obvious to combine the teachings of McDonald and Wang to arrive at the claimed invention, for at least the following reasons.

One of ordinary skill in the art would not have combined a system and method which imperatively uses a centralized database (i.e., a centralized system and method), as

disclosed by McDonald, with the decentralized system and method which is disclosed by Wang.

In other words, Appellants submit that it would not have been obvious to modify the teachings of McDonald, which are directed to a centralized database, as alleged by the Examiner.

For example, as the Examiner points out, McDonald does not explicitly disclose displaying the subject information on a display device of a digital camera (see Office Action at page 3, last paragraph).

Instead, McDonald discloses that patient and patient admission information are stored on a database server 24 (see Figure 1), which obtains access to a central database. McDonald further discloses that capture stations 26 make requests for information to the database server 24 which in turn retrieves data (e.g., see McDonald at column 4, lines 58-67).

McDonald discloses that it is “*imperative that ultrasound scan facilities such as hospitals maintain impeccable records for identifying and tracking ultrasound scans to ensure that each scan is accurately and permanently associated with a specific patient and a specific date*” (see McDonald at column 5, lines 1-5; emphasis added).

McDonald further discloses that the patient search parameter is dispatched in a message to the database server 24 which searches for a match in the database (e.g., see McDonald at column 5, lines 12-14).

In comparison, as the Examiner also points out, Wang discloses that the personal identifier and management system is a single stand-alone portable hand held device that fits into a user's single hand (see Wang at column 8, lines 59-61).

Indeed, Wang further discloses that the image database, the image capturing system, the display system, and the face analysis system all physically reside in the single stand-alone portable hand held device (see Wang at column 8, lines 59-61).

Appellants submit, however, that having the image database, the image capturing system, the display system, and the face analysis system all physically reside in a single stand-alone portable hand held device would not “*maintain impeccable records for identifying and tracking ultrasound scans to ensure that each scan is accurately and permanently associated with a specific patient and a specific date*”, as McDonald specifically states is an “*imperative*” object of McDonald's system and method (see McDonald at column 5, lines 1-5).

In other words, Appellants respectfully submit that it would not have obvious to modify the system and method of McDonald, which states that it is “*imperative that ultrasound scan facilities such as hospitals maintain impeccable records for identifying and tracking ultrasound scans to ensure that each scan is accurately and permanently associated with a specific patient and a specific date*” (see McDonald at column 5, lines 1-5; emphasis added) and which performs a search of a central database, in view of Wang, which discloses a personal identifier and management system that is a single stand-alone portable hand held device that fits into a user's single hand, wherein the image database, the image capturing system, the display system, and the face analysis



system all physically reside in the single stand-alone portable hand held device (see Wang at column 8, lines 59-61).

Appellants submit that it is not enough to merely “pick-and-choose” the elements of the claimed invention from the references and combine them to arrive at the invention.

Instead, the references must provide some motivation for doing that which the inventors have done. That is, there must be some motivation or suggestion for combining the references to arrive at the claimed invention.

Since the principle of operation of each of these references clearly are different from one another (e.g., centralized versus decentralized), a substantial reconstruction of the operation of the references would need to be done to arrive at the claimed invention.

However, neither of the references provides any teaching or motivation for such a reconstruction of the systems and methods to provide the claimed combination.

In comparison, the claimed invention is directed to an exemplary image recording method and apparatus which can simplify the input of identification information on a subject, which enables an easy check on the correspondence between the subject identification information input before photographing and the subject to be photographed, and which can automatically record information in a format suitable for a database (e.g., see specification at page 3, lines 11-16).

For example, the claimed invention is particularly suitable for use in taking photographs (e.g., diagnosis images) of a subject (e.g., a patient, an affected part or limb of a patient, etc.) for medical diagnosis. It is noted that the claimed invention is not limited only to patients and/or medical applications.

Appellants respectfully submit that, absent the benefit of Appellants' own invention (i.e., impermissible hindsight based analysis), it would not have obvious to modify the system and method of McDonald, which states that it is "*imperative that ultrasound scan facilities such as hospitals maintain impeccable records for identifying and tracking ultrasound scans to ensure that each scan is accurately and permanently associated with a specific patient and a specific date*" (see McDonald at column 5, lines 1-5; emphasis added) and which performs a search of a central database, with Wang, which discloses a personal identifier and management system that is a single stand-alone portable hand held device that fits into a user's single hand, wherein the image database, the image capturing system, the display system, and the face analysis system all physically reside in the single stand-alone portable hand held device (see Wang at column 8, lines 59-61).

In other words, one of ordinary skill in the art would not have combined a system and method which imperatively uses a centralized database (i.e., a centralized system and method), as disclosed by McDonald, with the decentralized system and method which is disclosed by Wang.

Thus, for the foregoing reasons, Appellants submit that it would not have been obvious to modify McDonald in view of Wang to arrive at the claimed invention.

Therefore, the Examiner maintained the final rejections of claims 1-41, as set forth in the final Office Action mailed on November 29, 2005.

Moreover, Appellants submit that McDonald and Wang, either individually or in combination, do not disclose or suggest all of the features of claims 1-3, 12, 37, 38, and 40.

Therefore, the Examiner is requested to reconsider and withdraw this rejection.

ii. Claims 4, 11, and 13 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over McDonald in view of Wang, and in further view of “Core Bibliographic Information in the TIFF Header”, [http://gdz.sub.uni-goettingen.de/en-old/tech\\_notes/tiffheader.html](http://gdz.sub.uni-goettingen.de/en-old/tech_notes/tiffheader.html), updated February 14, 1999) (hereinafter “TIFF”).

Appellants submit that dependent claims 4, 11, and 13 also are not rendered obvious from McDonald in view of Wang, and further in view of TIFF by virtue of their dependency from independent claim 1, as well as for the additional features recited therein.

That is, TIFF does not make up for the deficiencies of McDonald and Wang, and indeed, is not relied upon for the features for which McDonald and Wang are deficient.

Thus, claims 4, 11, and 13 clearly would not have been obvious over McDonald, Wang, and TIFF, either individually or in combination.

iii. Claims 5-7, 9, 10, 15-17, 19-21, and 39 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over McDonald in view of Wang, and further in view of Kuperstein (U.S. Patent No. 6,128,398).

First, Appellants submit that dependent claims 5-7, 9, 10, and 39 also are not rendered obvious from McDonald in view of Wang, and further in view of Kuperstein by virtue of their dependency from independent claim 1, as well as for the additional features recited therein.

That is, Kuperstein does not make up for the deficiencies of McDonald and Wang, and indeed, is not even relied upon for the features for which McDonald and Wang are deficient, as set forth above.

Dependent claims 16, 17, 20, and 21 also are patentable over Wang and Kuperstein, either individually or in combination, by virtue of their dependency from claims 15 and 19, respectively, as well as for the additional features recited therein.

Thus, Appellants request that the Examiner reconsider and withdraw the rejection of claims 5-7, 9, 10, 15-17, 19-21, and 39.

iv. Claims 8, 18, and 22 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over McDonald in view of Wang, and further in view of Kuperstein, and further in view of TIFF.

First, Appellants respectfully submit that the Examiner clearly has not provided any evidentiary basis for the motivation in the rejection of claims 8, 18, and 22 under 35 U.S.C. § 103(a) as being unpatentable over McDonald, Wang, Kuperstein, and TIFF. Thus, Appellant submits that a *prima facie* case of obviousness has not been properly established at least with respect to claims 8, 18, and 22 of the present application.

Instead, the Examiner states only that it would have been obvious to combine McDonald, Wang, Kuperstein, and TIFF “*to record the identification information loaded in the information loading step, in a header part of an image file in which the photographed subject image is recorded, motivation being the ability to sort and process digital images in a computer*” (see Office Action mailed November 29, 2005, at page 10, lines 10-14).

However, no citation to any of the cited references has been provided for such stated motivation. Thus, Appellants respectfully submit that the Examiner clearly has not provided any evidentiary basis for the motivation in the rejection of claims 8, 18, and 22 under 35 U.S.C. § 103(a).

Hence, the Office Action fails to establish a *prima facie* case of obviousness.

In view of the foregoing arguments, Appellants submit that the Office Action fails to meet the Examiner's initial burden of establishing a *prima facie* rejection, since the Examiner clearly has not provided any evidentiary basis for the motivation in the rejection of claims 8, 18, and 22 under 35 U.S.C. § 103(a) as being unpatentable over McDonald, Wang, Kuperstein, and TIFF.

Notwithstanding the above, Appellants submit that dependent claims 8, 18, and 22 also are not rendered obvious from McDonald in view of Wang, and further in view of Kuperstein, and further in view of TIFF by virtue of their dependency from independent claims 1, 15, and 19, respectively, as well as for the additional features recited therein.

That is, neither Kuperstein nor TIFF makes up for the deficiencies of McDonald and Wang, as set forth above.

Thus, Appellants submit that McDonald, Wang, Kuperstein, and TIFF, either individually or in combination, clearly do not disclose or suggest all of the features of dependent claims 8, 18, and 22.

Thus, Appellants request that the Examiner reconsider and withdraw the rejection of claims 8, 18, and 22.

v. Claims 14 and 23-36 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Allen et al. (U.S. Patent No. 5,737,491).

In response to Appellants' traversal positions, the Examiner states that:

Applicant has not disclosed that inputting the destination information before photographing provides an advantage, is used for a particular purpose or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected Applicants' invention to perform equally well with the destination information being input after photographing because transmitting a recording cannot occur until the destination information is input and the order is not critical.

(see Office Action at page 11, lines 17-21, and page 12, lines 1-2).

However, Appellants respectfully disagree with the Examiner's position for several reasons. Therefore, Appellants respectfully traverse this rejection.

For example, Appellants note that the Description of the Related Art of the present application identifies numerous examples of problems associated with entering information after the photograph is taken (e.g., see specification at page 1, line 12, to page 3, line 3).

The present application also explains that the claimed invention solves such problems. For example, the invention discloses that by loading the image destination information from the external device, the photographed image can be transmitted to the destination indicated by the destination information (e.g., see specification at page 5, lines 18-20; see also page 14, line 3, to page 18, line 2).

The present application further explains that, by loading the information (such as the image destination information) from the external device before photographing the subject, input errors can be prevented because the present invention requires no manual inputs (e.g., see specification at page 4, lines 22-23; see also page 14, line 3, to page 18, line 2).

Thus, contrary to the Examiner's position, Appellants have identified and explained the advantages of the claimed invention and the problems solved by the claimed invention. Appellants also have explained the criticality of loading such information into the digital camera from an external device before photographing the subject with the digital camera, as set forth above.

Contrary to the Examiner's position, such problems clearly would not be solved by allegedly inputting the destination information after photographing, nor does Allen disclose or suggest how such problems would be solved.

Also, contrary to the Examiner's position, although transmitting a recording cannot occur until the destination information is input, Appellants clearly have explained the criticality of loading such information into the digital camera from an external device before photographing the subject with the digital camera, as set forth above.

Appellants incorporate herein by reference all of the traversal arguments set forth in the Amendment under 37 C.F.R. § 1.111 filed on September 28, 2005, for the Examiner's convenience.

Appellants reiterate that Allen clearly does not disclose or suggest that such information loaded into the camera includes “*an input step of inputting destination information from an external device to a digital camera, the information being indicative of a destination of an image, wherein said input step inputs destination information to the digital camera using radio communication before photographing a subject to be photographed*” as claimed in independent claim 14.

Indeed, Appellants reiterate that the device and method of Allen are not even concerned with inputting destination information of the image before taking the photograph of the subject, as with the claimed invention. Instead, Allen merely is directed to taking photographs (for example, by a sports photographer at a sporting event) and transmitting (using voice commands) such photographs to a destination via a wireless transmission to a local image fulfillment center for printing or further transmission (e.g., see Allen at column 1, lines 57-65).

Thus, for the foregoing reasons, independent claim 14 clearly is not anticipated by, or rendered obvious from, the disclosure of Allen.

For somewhat similar reasons as independent claim 14, Appellants reiterate that Allen also does not disclose or suggest all of the features of independent claims 23 and 36. Thus, Appellants submit that Allen does not anticipate, or render obvious, the novel and unobvious combination of features defined by independent claims 23 and 36.



For the foregoing reasons, Appellants reiterate that all of the features of claims 14, 23, and 36 clearly are not disclosed or suggested by Allen.

Therefore, the Examiner respectfully is requested to reconsider and withdraw this rejection and permit claims 14 and 23-36 to pass to immediate allowance.

vi. Claim 41 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over McDonald in view of Wang, and further in view of Allen.

Somewhat similarly to claim 1 above, independent claim 41 recites an image transmitting method, including:

*inputting identification information on a subject and subject information, and destination information from an external device to a digital camera, before photographing the subject,*

*wherein the subject information includes information used by a photographer to confirm the identity of the subject, before photographing the subject, and*

*wherein the destination information includes information indicative of a destination of an image;*

*displaying, on the basis of the subject information, subject information for confirming the identity of the subject on a display device of the digital camera, before photographing the subject;*

*photographing the subject using the digital camera after confirming the identity of the subject on the basis of the subject information displayed on the display device;*

*recording the photographed image of the subject in connection with the identification information and the destination information input; and*

*transmitting the photographed subject image to the destination corresponding to the destination information, on the basis of the destination information recorded in connection with the image (emphasis added).*

For somewhat similar reasons as those set forth above with respect to claim 1, McDonald and Wang clearly do not disclose or suggest all of the features of independent claim 41.

Moreover, Allen does not make up for the deficiencies of McDonald and Wang, as set forth above.

Thus, the Examiner is requested to reconsider and withdraw the rejection of independent claim 41.

In view of all of the foregoing, Appellants submit that all of the pending claims (i.e., Claims 1-41) are patentable over the prior art of record.

#### **VIII. CONCLUSION**

In view of the foregoing, Appellants submit that Claims 1-41 of the application are patentably distinct from the prior art of record and in condition for allowance.

Thus, the Board is respectfully requested to remove each of the rejections of Claims 1-41 under 35 U.S.C. § 103(a).

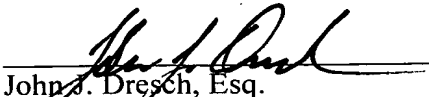
Appellant's Reply Brief on Appeal  
Serial No. 10/058,924  
Docket No. FJ-2001-041-US  
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Respectfully Submitted,

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**CLAIMS APPENDIX**

1. An image recording method, comprising:
  - an information loading step of loading identification information on a subject and subject information used by a photographer to confirm an identity of the subject, in a digital camera before photographing the subject;
  - a display step of displaying, on the basis of the subject information, subject information used by the photographer to confirm the identity of the subject on a display device of the digital camera before photographing the subject;
  - a photographing step of photographing the subject using the digital camera after confirming the identity of the subject on the basis of the subject information displayed on the display device; and
  - a recording step of recording the photographed image of the subject in connection with the identification information loaded in the information loading step.
2. The image recording method according to claim 1, wherein the image recorded in connection with the identification information is saved to a database.
3. The image recording method according to claim 2, wherein the subject information comprises at least one of the subject's photograph and name.

4. The image recording method according to claim 2, wherein the recording step records the identification information loaded in the information loading step, in a header part of an image file in which the photographed subject image is recorded.

5. The image recording method according to claim 1, wherein the information loading step comprises:

a step of reading the subject identification information from a recording medium having the identification information recorded thereon;

a step of reading the subject information corresponding to the read identification information, from a database having the subject information already stored in connection with the subject identification information; and

a transmitting step of transmitting the subject information read from the database, to the digital camera together with the identification information read from the recording medium.

6. The image recording method according to claim 5, wherein while the subject identification information and the subject information are being transmitted to the digital camera, the digital camera is inhibited from being used for photographing.

7. The image recording method according to claim 5, wherein the subject information comprises at least one of the subject's photograph and name.

8. The image recording method according to claim 5, wherein the recording step records the identification information loaded in the information loading step, in a header part of an image file in which the photographed subject image is recorded.

9. The image recording method according to claim 5, wherein:  
the step of reading the identification information reads plural pieces of identification information so that these pieces can be accumulated; and  
the transmitting step transmits the identification information and the subject information in response to an information obtainment request from the digital camera.

10. The image recording method according to claim 9, wherein while the subject identification information and the subject information are being transmitted to the digital camera, the digital camera is inhibited from being used for photographing.

11. The image recording method according to claim 1, wherein:  
the information loading step loads recorded image information containing at least one of image format, the number of pixels, compression rate, file size, and image aspect ratio; and  
the digital camera records the photographed image on the basis of the loaded recorded image information.

12. The image recording method according to claim 1, wherein the subject information comprises at least one of the subject's photograph and name.
13. The image recording method according to claim 1, wherein the recording step records the identification information loaded in the information loading step, in a header part of an image file in which the photographed subject image is recorded.
14. An image transmitting method, comprising:
  - an input step of inputting destination information from an external device to a digital camera, the information being indicative of a destination of an image, wherein said input step inputs destination information to the digital camera using radio communication before photographing a subject to be photographed;
  - a photographing step of photographing the subject using the digital camera;
  - a recording step of recording the photographed image of the subject in connection with the destination information input in the input step; and
  - a transmitting step of transmitting the photographed subject image to the destination corresponding to the destination information, on the basis of the destination information recorded in connection with the image.
15. An image recording apparatus, comprising:
  - an input device which reads identification information on a subject from a recording medium having the information recorded thereon;

an information transmitting device which reads subject information corresponding to the read identification information, from a database having the subject information already stored in connection with the subject identification information and transmits the subject information read from the database, together with the identification information read from the recording medium, wherein said subject information comprises information that can be used to confirm an identity of said subject to be photographed;

a receiving device which receives the identification information and the subject information;

a display device which displays the subject information on the basis of the received subject information before photographing the subject;

a photographing device which photographs the subject; and

a recording device which records the photographed subject image in connection with the received identification information.

16. The image recording apparatus according to claim 15, wherein the recording medium comprises one of a card, a magnetic card, and an IC card including a bar code recorded thereon, and the input device comprises a card reader.

17. The image recording apparatus according to claim 15, further comprising a communication device which transmits the image recorded in connection with the identification information, to the database.



18. The image recording apparatus according to claim 15, wherein the recording device records the identification information in a header part of an image file in which the photographed subject image is recorded.

19. An image recording apparatus, comprising:

an input device which reads subject identification information and subject information from a recording medium having the identification information and the subject information recorded thereon, wherein said subject information comprises information that can be used to confirm an identity of said subject to be photographed;

a display device which displays the subject information on the basis of the read subject information before photographing the subject;

a photographing device which photographs the subject; and

a recording device which records the photographed image of the subject in connection with the read identification information.

20. The image recording apparatus according to claim 19, wherein the recording medium comprises one of a card, a magnetic card, and an IC card including a bar code recorded thereon, and the input device comprises a card reader.

21. The image recording apparatus according to claim 19, further comprising a communication device which transmits the image recorded in connection with the identification information, to the database.

22. The image recording apparatus according to claim 19, wherein the recording device records the identification information in a header part of an image file in which the photographed subject image is recorded.

23. An image recording method, comprising:

inputting added-to-image information added to an image of a subject to be photographed and display information associated with the added-to-image information to a digital camera from an external device using radio communication before photographing the subject to be photographed;

displaying the display information on a display device of the digital camera on the basis of the display information input from the external device before photographing the subject to be photographed; and

after photographing the subject, recording an image of the subject and the added-to-image information input from the external device in connection with the image.

24. The image recording method according to claim 23, wherein the display information is used by a photographer to check at least one of contents and correctness of the added-to-image information added to the subject image.

25. The image recording method according to claim 24, wherein the display information comprises one of test information and image information which can be displayed on the display device.
26. The image recording method according to claim 24, wherein the added-to-image information comprises binary information, and the display information comprises text information corresponding to the binary information.
27. The image recording method according to claim 24, wherein the added-to-image information is recorded in a header part of an image file in which an image of the subject is recorded.
28. The image recording method according to claim 23, wherein the display information comprises at least one of test information and image information which can be displayed on the display device.
29. The image recording method according to claim 23, wherein the added-to-image information comprises binary information, and the display information comprises text information corresponding to the binary information.

30. The image recording method according to claim 23, wherein the added-to-image information is recorded in a header part of an image file in which an image of the subject is recorded.

31. The image recording method according to claim 23, wherein the added-to-image information comprises at least one of numerical locational information on the subject and identification information already imparted to the subject.

32. The image recording method according to claim 31, wherein the display information is used by a photographer to check at least one of contents and correctness of the added-to-image information added to the subject image.

33. The image recording method according to claim 32, wherein the display information comprises one of test information and image information which can be displayed on the display device.

34. The image recording method according to claim 32, wherein the added-to-image information comprises binary information, and the display information comprises text information corresponding to the binary information.

35. The image recording method according to claim 32, wherein the added-to-image information is recorded in a header part of an image file in which an image of the subject is recorded.

36. An image recording system, comprising:

an external device which outputs, using radio communication, added-to-image information added to an image of a subject to be photographed and display information associated with the added-to-image information; and

a digital camera comprising:

a display device which displays the display information on the basis of the display information input from the external device using radio communication before photographing the subject to be photographed; and

a recording device which records an image of the subject after the subject has been photographed and records the added-to-image information input from the external device, in connection with the image.

37. The image recording method according to claim 1, wherein said identification information comprises information that can be used to confirm an identity of said subject to be photographed.

38. The image recording method according to claim 1, further comprising:  
confirming an identity of said subject to be photographed using the subject information.
39. The image recording method according to claim 1, wherein said information loading step comprises at least one of loading said identification information in the digital camera using radio communication and loading said identification information from a recording medium.
40. The image recording method according to claim 1, wherein said information loading step automatically loads the identification information on the subject and the subject information used by the photographer to confirm the subject, in the digital camera before photographing the subject.
41. An image transmitting method, comprising:  
inputting identification information on a subject and subject information, and destination information from an external device to a digital camera, before photographing the subject,  
wherein the subject information includes information used by a photographer to confirm the identity of the subject, before photographing the subject, and  
wherein the destination information includes information indicative of a destination of an image;

displaying, on the basis of the subject information, subject information for confirming the identity of the subject on a display device of the digital camera, before photographing the subject;

photographing the subject using the digital camera after confirming the identity of the subject on the basis of the subject information displayed on the display device;

recording the photographed image of the subject in connection with the identification information and the destination information input; and

transmitting the photographed subject image to the destination corresponding to the destination information, on the basis of the destination information recorded in connection with the image.

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(MAS.012)

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**EVIDENCE APPENDIX**

Not applicable.

**RELATED PROCEEDINGS APPENDIX**

Not applicable.